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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,674	05/13/1999	PENINA KATZ	WMA-96-015AA	1540

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TECHNOLOGY LAW DEPARTMENT
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EXAMINER

CHOI, KYLE JAEHUN

ART UNIT	PAPER NUMBER
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3623

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DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,674

Applicant(s)

KATZ, PENINA

Examiner

Kyle J. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a **non-final** Office Action in response to the communication received on September 25, 2002. By the amendment of August 10, 2001:

Claims 1, 7-9, 16, 17, 24-29 have been amended; and
Claims 30-32 have been added.

Claims 1-32 are now pending in this application and have been examined on the merits as discussed below.

Response to §1.105 Request

2. In response to the Rule 105 requirement mailed August 2, 2002 requesting further information on the "Automatic Time Monitor" submitted by the applicant in an IDS on April 17, 2000, applicant's communication indicating that there is no further information regarding the matter is acknowledged. Although one of the references directed to the Automatic Time Monitor submitted by the applicant has a hand-written notation stating "1988-1989 manual", this date could not be substantiated and therefore is deemed to be unreliable for the purposes of prosecution of this application. Accordingly, the IDS directed to the "Automatic Time Monitor" is not considered to be valid prior art for the purposes of this Office Action. [Applicant's attention is directed to the fact that a copy of the computer

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program print out for the Automatic Check-In Monitor was registered with the Copyright Office on June 14, 1990, less than month after the filing of the parent application from which the current application claims priority (see PTO Form 892, attached hereto).]

Response to Amendment

3. In response to the amendment received on August 10, 2001, the examiner as conducted an updated search and found new art not applied previously. Therefore, all indications of allowability in the previous Office Actions are ***vacated*** in light of the newly discovered art.

4. Moreover, new objections as set forth below are in response to the newly added claims 30-32.

Claim Objections

5. **Claims 30-32** are objected to for being redundant. Claims 30-32 recite the same invention as recited in amended independent claims 8, 16, and 24, respectively. Prior dependent claims 8, 16, and 24, each depending from independent claims 1, 9, and 17, respectively, have been rewritten in independent form incorporating all the limitations of their respective independent claims. The newly added claims 30-32 recite exactly

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the same limitations of prior dependent claims 8, 16, and 24, respectively, and has the exact same dependency to independent claims 1, 9, and 17, respectively. Consequently, amended independent claim 8 now recites exactly the same invention as newly added dependent claim 30 once the limitations of its independent claim (i.e., claim 1) is taken into consideration based on its dependency. The same issue exists for amended independent claims 16 and 24 with newly added dependent claims 31 and 32, respectively. Applicant must either cancel the redundant claims or amend the dependent claims to depend from different base claims or change the limitations such that the claims are no longer redundant.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the

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examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 1-6, 8-13, 15-22, 24-32** are rejected under 35 U.S.C. 102(e) as being anticipated by **Oliver (US Pat. No. 4,839,917)**.

As to **claims 1-4, 8, 9, 15, 16-20, 24-32**, Oliver teaches a method and system for personnel tracking (col. 13, ln. 3). The employee calls from various work locations with the employees PIN and the call is recorded including the location, employee ID, and the time of the call (i.e., if the employee does not call within a specified time, an alarm is generated). (col. 13, lns. 5-21).

As to **claims 5, 6, 10-13, 21, 22**, Oliver teaches using PBX system to automatically detect the call's origin and location. Therefore, Oliver teaches the equivalent of ANI and caller ID systems at the time of the invention and therefore is considered to be inherent in Oliver to use any equivalent device to obtain the same result.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hedges (US Pat. No. 3,819,862)**.

As to claims 1-4, 8, 9, 15-20, 24-32, Hedges teaches a method and system for tracking employees (col. 1, lns. 18-20, 22-29). The employees call in from various worksites (e.g., different rooms in a hotel; col. 6, lns. 15-20) from a telephone, which has connected thereto a device that transmits location information (col. 6, lns. 15-20; col. 11, ln. 15), employee information (col. 11, lns. 47-50), and nature of the call (e.g., beginning a task, ending a task, or inspecting the job performed; col. 12, lns. 14-26) to a central computer (col. 2, lns. 3-4, 43-48; col. 3, lns. 36-39) which collects the data for providing a record to be monitored and printed by the management (col. 6, lns. 1-3).

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Hedges does not specifically teach that the call is time stamped. However, examiner takes Official Notice that it is notoriously old and well known to time stamp calls that are received to verify when a call was accepted. (See references already of record. Almost every single one teaches that it is old and well known to time stamp call records for various purposes). One would have been motivated to time stamp the calls as disclosed in Hedges because Hedges teaches that one of the desires in the hotel industry is that the "supervisory personal know where the maintenance personnel are and **when** the maintenance in a particular room is completed." (col. 1, lns. 27-29, emphasis added). It is notoriously old and well known to one of ordinary skill in the hotel management art that "when" a room is ready includes not only whether a room is currently ready, but at what instant (i.e., time) a room became ready in order to assess how long a room as gone by without being booked. It is also notoriously old and well known that management keeps track of how long it takes for a room to be ready in order to assess performance levels of their employees. Consequently, it would have been obvious for one of ordinary skill in the art at the time of the invention to have time stamped the calls from the employees to determine "when" a room becomes available as taught by Hedges.

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As to *claims 5, 6, 10-13, 21, 22*, Hedges does not specifically teach that the telephone uses ANI or caller ID to determine the original or location of the calls. However, the mechanism for which Hedges uses to determine the telephone and location of the calls are the equivalent of ANI and call ID systems at the time of the invention. In particular, Hedges teaches that a device is used to transmit an ID of the telephone set to the computer, the telephone ID being associated with a particular room. This is the same principle on which ANI and caller ID is based. Hedges being a 1974 patent, it would have been obvious to one of ordinary skill in the art at the time of the invention to have appreciated that ANI and caller ID, both being notoriously well known at the time of the invention to identify the caller/location, is the equivalent of the device used by Hedges to identify the location of the call. Hence, one with ordinary skill in the art would have been motivated to use a well known, more modern technology at the time of the invention to perform the same functionality as taught by Hedges.

As to *claims 7, 14, 23*, Hedges does not teach that the telephones used are cellular phones. However, Hedges does teach using alternative communicating devices, such as the television cable, to communicate with the central computer. Cellular phones are modern versions of land-based telephones with the

same features but wireless. Hence, one with ordinary skill in the art would have been motivated to use a well known, more modern technology at the time of the invention to perform the same functionality as taught by Hedges.

Conclusion

10. No claims allowed.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Klausner et al.** (US Pat. No. 4,304,968) discloses recording the caller name and telephone number and time stamping the record to print out a report of the calls received.
- **Tazaki et al.** (JP 62-117452) discloses personnel tracking method and system using a device connected to the telephone.
- **"Automatic Check-in Monitor"** Copyright registration record shows that the Automatic Check-in Monitor system submitted by the applicant's IDS was registered with the Copyright office in June of 1990.
- **MITC** (Management Information Technology Corp) began a business in 1990 related to timekeeping and tracking of employees.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kyle J. Choi** whose telephone number is (703)306-5845. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz** can be reached on (703)305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is (703)308-1113.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-5548 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park
5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


KYLE J. CHOI
PRIMARY EXAMINER
Art Unit 3623
December 27, 2002